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Application No. 10/803,349
 Amendment dated November 3, 2006
 Reply to Office Action of August 3, 2006

NOV 03 2006

Docket No.: 29617/SH009A

REMARKS

Claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 29, 44-46, 49-54, and 56 were examined in a first, non-final office action issued on August 3, 2006. Claims 3-6, 8, 13, 17, 19, 22, 23, 25-38, 40-43, 47, 48, 55, and 57-77 stand withdrawn as directed to a non-elected species, and the election requirement was made final. The abstract, the specification, and claim 16 stand objected to for various alleged informalities. Claims 46 and 56 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 1, 2, 9, 10, 14, 16, 18, 20, 45 and 49-52 stand rejected as anticipated by Ross, U.S. patent No. 2,073,719. Claims 11, 12, 21, 44, 53 and 54 stand rejected under 35 U.S.C. § 103(a) as obvious over Ross. Claims 7, 15, 24, 39, 46 and 56 stand rejected as obvious over Ross in view of Connors, U.S. Patent No. 6,283,661. Reconsideration and withdrawal of the aforementioned rejections and objections are respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing, the specification, the abstract, and claims 1, 7, 9, 11, 12, 16, 20, 21, 24, 39 and 45 have been amended, claims 46 and 56 have been canceled without prejudice or disclaimer, and new independent claim 78 has been presented. No new matter has been added.

The applicants hereby give the PTO permission to charge our Deposit Account No. 13-2855 for the fee of \$200 for an additional independent claim.

Abstract Objection

The abstract stands objected to for reciting "disclosed herein." The abstract has been amended to delete the objected to language. Withdrawal of this objection is respectfully requested.

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Specification Objection

The disclosure stands objected to for various informalities regarding improper reference numerals. Specifically, the office asserts that in paragraph 55, 'body 950' should read 'body 951,' in paragraph 56, 'flag cartridge 920' should read 'flag cartridge 901,' and in paragraph 57, 'flag cartridge 950' should read 'flag cartridge 901,' and 'cap 960' should read 'highlighter 950.' The foregoing amendments have been made to the specification.

Next, the Office alleges that the specification fails to provide proper antecedent basis for the claimed subject matter. First, the claim term "dispenser housing" of claim 1 is alleged to lack antecedent basis in the specification. Paragraph 67 has been amended to indicate that a cartridge cap is an example of a dispenser housing. The Office next alleges that the terms "barrel portion" from claim 7 and "insertion cylinder" from claims 24 and 39 lack antecedent basis in the specification with regard to the elected embodiment. The Office states that it has examined these terms as corresponding to the nub 902. To address this objection, claims 7, 24, and 39 have been amended to recite a nub. Accordingly, the objections to the specification should be withdrawn.

Claim Objection

Claim the 16 stands objected to because the office alleges that the claim language "dispenser base" should be "dispenser housing." Claim 16 has been amended as suggested.

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Claim Rejections – Indefiniteness

Claims 46 and 56 stand rejected because it is allegedly unclear whether these claims positively recite a writing instrument. Both claims 46 and 56 have been canceled. The subject matter of claim 46 has been incorporated into independent claim 45. Claim 45 recites that the base comprises a nub adapted to be releasably engaged in a recess in the writing instrument. Withdrawal of this rejection is respectfully requested.

Claim Rejections – Prior Art

Claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 29 and 44 are Allowable

Claim 1 recites a writing instrument including, in part, a writing cap removably disposable over the writing tip, the writing cap including a nub, and the dispenser housing including a recess sized and shaped to releasably receive the nub of the writing cap.

Neither Ross nor Connors discloses or suggests a writing cap at all, much less a writing cap including an nub. Further, neither reference discloses a dispenser housing with a recess adapted to receive the nub. Claim 1 is allowable for these reasons alone.

The claimed elements provide for consumer convenience not found in the sheet material housing devices disclosed in the prior art references. The recess of the dispenser housing can conveniently receive the nub of the writing cap to store the writing cap while the writing utensil is being used. When the writing utensil is not in use, the writing cap can be placed over the writing tip to seal the writing tip. Further, the dispenser housing and the dispenser base combine to form a cartridge, that, in one embodiment, is releasable from the writing utensil. When the cartridge runs out of sheet material, the housing and base can be removed from the writing instrument and replaced with a new dispenser housing and base, without compromising the structural integrity of the writing utensil itself. In other words, the

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consumer is able to continue writing with the writing utensil even after the cartridge is removed. Neither of Ross or Connors discloses or suggests this type of versatility.

Accordingly, claim 1 is allowable over the art of record. Dependent claims 2, 7, 9-12, 14-16, 18, 20, 21, 24, and 29 are allowable for at least the same reasons.

Claims 45 and 49-54 are Allowable

Claim 45 recites a sheet material cartridge including, in part, a base adapted for removable attachment to the writing instrument and a housing coupled to the dispenser base, wherein the base comprises a nub adapted to be releasably engaged in a recess in the writing instrument, and the housing comprises a rear surface including a recess sized to releasably engage a nub from a writing cap.

Claim 45 is allowable for the same reasons that claim 1 is allowable. Neither of the cited references discloses or suggests a sheet material cartridge having a base with a nub and a housing with a rear surface having a recess. The claimed base and nub structure allows the cartridge to be releasably attached to the rear end of a writing utensil. When empty, the entire cartridge can be removed and replaced with a full cartridge without compromising the integrity of the writing utensil. Further, the claimed housing rear surface and recess structure allows a writing cap to be releasably stored on the cartridge when the writing utensil is in use. Neither of Ross or Connors disclose a writing cap, and therefore neither could not suggest a recess sized and shaped to receive a cap. Accordingly, claim 45 is allowable. Dependent claims 49-54 and 56 are allowable for at least the same reasons.

New Claim 78 is Allowable

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Claim 78 recites a writing instrument including, in part, a body portion having a sealed rear end, the sealed rear end including a recess, a dispenser base including a nub releasably disposable in the recess of the sealed rear end, and a roll of sheet material disposed in the housing interior receptacle formed in part by the base.

Ross, on the other hand, fails to disclose a dispenser base releasably disposed in the recess of a sealed rear end as recited by claim 78. Ross discloses a single tube having opposing portions 11 and 12 each attached to a fixed collar 13. A roll of paper is disposed in the tube 11. However, the tube 11 does not include a nub, and the tube 11 is not releasably disposed in the recess of a sealed rear end. To the contrary, the tube 11 is affixed to the collar 13 to form a portion of the body of the writing utensil. The claimed construction allows a user to quickly change out paper within the housing by simply taking the entire housing and base off the writing utensil and replacing it with a new housing and base with a full complement of sheet material.

Collins also fails to disclose a base releasably disposed in the recess of a sealed rear end. Collins discloses that the writing utensil 14 has an open rear end with connector 16 screwed into the open rear end. Further, the connector 16 itself is open throughout, i.e., not sealed, to accommodate a tube 22 full of ink 24. Accordingly, the claimed construction is novel over the art of record.

The recited writing instrument is also non-obvious over Ross and Collins. The sealed rear end allows a user to remove the base from the sealed end of the writing utensil (and exchange the cartridge) without exposing the interior of the writing utensil to ambient atmosphere. When the connector 16 of Collins is removed, the ink 24 is exposed to ambient atmosphere, and if the connector is removed for a long enough period the writing utensil would be subjected to dry out. The claimed construction is particularly helpful with a marker,

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which is even more subject to dry out than ink pens. Ross fails to disclose a removable base at all, much less a base removably disposed in a sealed end, and therefore does not suggest the noted features. Allowance of claim 78 is respectfully requested.

CONCLUSION

The applicant respectfully submits that the pending application is in condition for allowance. If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29617/SH009A/US.

Dated: November 3, 2006

Respectfully submitted,

By 

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